

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No.10/585,681
Filing Date July 10, 2006
Confirmation No. 4703
Inventor..... Udi Chatow
Group Art Unit 1795
Examiner Rachel L. Burney
Attorney's Docket No.200311091-2
Title:..... Printing of Images with Selective Gloss and Toners Therefore

37 C.F.R. § 1.144 PETITION FROM REQUIREMENT FOR RESTRICTION

To: Commissioner for Patents
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REMARKS

Applicant respectfully requests review by the Director of the restriction requirement in the September 16, 2008 Office Action, which was timely traversed by the Applicant and subsequently made final by the Office. Pursuant to 37 C.F.R. §§ 1.181(d) and 1.144, no fee is believed due. However, this Petition is accompanied by a deposit account fee authorization.

Claims 1, 8-12, 17-24, 28-32, 34-36, 38, 40, and 41 are pending in the application. Claims 34-36, 38, 40, and 41 are withdrawn from consideration (in addition to claims 18-24 and 28-32). Applicant previously elected Group I, claims 1, 8-12, and 17. Applicant traversed on the grounds that the basis

for determining Group I and III do not relate to a single general inventive concept is incorrect.

Page 2 of the September 16, 2008 Office Action states that the printer of Group III does not require the limitations of the matte toner present in claim 1 of Group I. On the contrary, claim 34 expressly requires the limitations of claim 1 by specific reference to claim 1. The remaining claims of Group III depend from claim 34. The remaining claims of Group I depend from claim 1. Consequently, Applicant asserts that the claims of Group I and III are entitled to consideration. Applicant requests examination of Group I and III in the next Office Action.

In addition, pursuant to MPEP § 806.05(c), restriction to claim 1 and the exclusion of claim 34 constitutes an improper restriction between a combination (claim 34) and subcombination (claim 1) where the subcombination is essential to the combination. Thus, Applicant further requests examination of Group I and III in the next Office Action.

Page 4 of the December 24, 2008 Office Action states that the above assertions are not persuasive because the instant application was filed under PCT rules and restriction is proper where there is a lack of unity. However, Applicant notes that the subject claims and the claims examined in the international application differ sufficiently that the previous finding of lack of unity does not apply to the subject claims.

Also, the December 24, 2008 Office Action alleges that Vanbesien teaches the claimed liquid toner may be used in any printing process and,

thus, it does not constitute a special technical feature among the claims. Applicant's Response to the December 24, 2008 Office Action clearly establishes that Vanbesien fails to anticipate the liquid toner in claim 1. Claim 34 expressly incorporates every limitation of claim 1. Consequently, the limitations of claim 1 constitute a special technical feature of the restricted claims and unity of invention exists among them, pursuant to PCT rules.

At least for the reasons indicated herein, the Office's requirement for restriction is improper. Applicant asserts that claims 34-36, 38, 40, and 41 are entitled to consideration in the present application. Applicant requests examination to that effect in the next Office Action.

Respectfully submitted,

Dated: March 18, 2009

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